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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/713,165

11/14/2003

Krishnan Chari

85500KNM

9809

7590

06/29/2006

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EXAMINER

GROSS, CHRISTOPHER M

ART UNIT

PAPER NUMBER

1639

DATE MAILED: 06/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/713,165

Applicant(s)

CHARI ET AL.

Examiner

Christopher M. Gross

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 22 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-33 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claims 1-33 are pending.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-12, 25, drawn to a coating composition, classifiable in class 435, subclass DIG 22.
- II. Claims 13-24, 26-29, drawn to a microarray, classifiable in class 435, subclass DIG 40.
- III. Claims 30-31, drawn to a method of making a microarray, classifiable in class 435, subclass DIG 49.
- IV. Claims 32-33, drawn to a microsphere composition, classified in class 435, subclass DIG 22.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II and IV are directed to related compositions. The related inventions are distinct if the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; the inventions as claimed are not obvious variants; and the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 806.05(j). In the instant case, each of the compositions I, II and III are mutually exclusive, are not obvious variants of one another and have different designs (structures) as well as potential differing modes of operation. Beyond microarray fabrication, the coating composition can be used in other

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products, such as paint whereas the microsphere composition can be for tasks like improving scratch resistance of a surface. Prior art searches of the physical properties and chemical structures are not coextensive for each invention I-III. A search of each of these inventions would require different key word and/or structures searches in different patent, non-patent literature and sequence databases. These searches would then require subsequent in-depth analysis of all relevant prior art literature and sequence references, placing a serious and undue burden on the Office in terms of both search and examination if inventions I II and III are put together.

Inventions II and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the process can be used to paint metal signs. Prior art searches of the microarray product that is invention II and method of preparation that is invention III are not coextensive. A search of each of these inventions would require different key word and sequence searches in different patent, non-patent literature and structure databases and require, at least, specific searches for particular method steps concerning invention III, not required for the physical and chemical elements of invention II. These searches would then require subsequent in-depth analysis of all relevant prior art literature and sequence references, placing a serious and undue burden on the Office in terms of both search and examination if II and III are put together.

Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions have not been disclosed as capable of use together and invention III is drawn to a method of making an array which entails the selection of a substrate, not necessary for the practice of invention I. A search of each of these inventions would require different key word and sequence searches in different patent, non-patent literature and structure databases and require, at least, specific searches for particular method steps concerning invention III, not required for the structure centered search of invention I. These searches would then require subsequent in-depth analysis of all relevant prior art literature and sequence references, placing a serious and undue burden on the Office in terms of both search and examination if I and III are put together.

Inventions IV and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions have not been disclosed as capable of use together and invention III is drawn to a method of making an array which entails the selection of a substrate, not necessary for the practice of invention IV. A search of each of these inventions would require different key word and sequence searches in different patent, non-patent literature and structure databases and require, at least, specific searches for particular method steps concerning invention III, not required for the structure centered search of

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invention IV. These searches would then require subsequent in-depth analysis of all relevant prior art literature and sequence references, placing a serious and undue burden on the Office in terms of both search and examination if III and IV are put together.

Because these inventions are distinct for the reasons given above and the search required for each of the groups is not required for each of the other groups, restriction for examination purposes as indicated is proper.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Election of Species

Each **genus** identified below is indicated in **bold**. Applicant is requested to elect one species from within *each* genus of the elected invention.

This application contains claims directed to the following patentably distinct species:

(From claims 1,2,13,32,33) **4-(phenylamino)cyclohexa-2,5-dienone derivative**: Applicant is required to elect a *single* particular structure, specified as to atom and bond from which the search will commence. Applicant is strongly encouraged to elect using a structural representation. Currently, claims 1,2,13,32,33 are generic.

(From claims 7-9) **microsphere diameter (microns)**: 1-50, 3-30, 5-20 from which the search will commence. Currently, claims 7-9 are generic.

(From claim 17) **substrate**: glass, plastic, cellulose acetate, polyethyleneterphthalate, from which the search will commence.

(From claims 19-21) **microspheres per square cm**: 100-1000000, 1000-200000, 10000-100000 from which the search will commence. Currently, claims 19-21 are generic.

(From claims 25-26) **interaction type**: chemical, physical, bioactive from which the search will commence. Currently, claims 25-26 are generic.

(From claim 27) **bioactive interface**: nucleic acid, protein from which the search will commence.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims

readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a). Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Gross whose telephone number is (571)272-4446. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Paras can be reached on 571 272-4517. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a


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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher M Gross
Examiner
Art Unit 1639

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MARK SHIBUYA, PH.D.
PATENT EXAMINER